

REMARKS

In response to the Office Action mailed April 3, 2007 (hereinafter “Office Action”), claims 10, 17, and 18 have been amended to provide a clearer presentation of the claimed subject matter. Support for the instant amendments is provided in figures 23 and 24 of the as-filed Specification. Thus, no new matter has been added. Reconsideration and the timely allowance of the pending claims, in view of the foregoing amendments and following remarks, are respectfully requested.

INFORMATION DISCLOSURE STATEMENT

Applicant thanks the Examiner for considering the references cited in the Information Disclosure Statement filed on July 29, 2003, as evidenced by the signed and initialed copy of the PTO-1449 Form returned with the Office Action.

SPECIFICATION

The Examiner indicated that a title of the invention is not descriptive and that a new title is required. Accordingly, Applicant has provided a new title that is clearly indicative of the invention to which the claims are directed.

CLAIM OBJECTIONS

The Examiner objected to claim 17 due to the following informalities: claim 17 recites “twp actions” in line 2 of the claim.

Applicant has amended claim 17 to recite “two actions” in place of “twp actions”, to overcome the claim objection. Accordingly, withdrawal of the claim objection is earnestly sought.

NON-STATUTORY DOUBLE PATENTING REJECTION

Claims 10-18 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-9 of U.S. Patent No. 6,633,337 (Togino) in view of U.S. Patent 5,485,504 (Ohnsorge).

Applicant traverses this rejection for *at least* the reason that the identified claims are not claiming the same invention. Claims 10-18 of the present application differ in scope with respect to the claims 1-9 of Togino, as claims 1-9 of Togino are directed to an electronic camera, whereas claims 10-18 of the present application are directed to a portable telephone comprising a telephone unit and a unit *separate* from the telephone unit being *connected to the telephone unit via a connector* and the separate unit having a two-dimensional display element and a magnifying optical system disposed therein.

The Examiner on page 4 of the Office Action, acknowledges that claims 1-9 of Togino fail to recite “a portable telephone” and asserts that Ohnsorge discloses a portable handheld device constructed to incorporate both camera and telephone features in a *single* body. In contrast, claims 10-18 of the present application require that the two-dimensional display and magnifying optical system be disposed in a unit *separate* from the telephone unit. Firstly, Applicant submits that the fact that the Examiner had to utilize on the Ohnsorge reference in addition to the Togino patent illustrates that the present application’s invention recited in claims 10-18 is an independent and distinct invention from the Togino patent. Secondly, Ohnsorge itself fails to disclose the features of claims 10-18 of the present invention, as Ohnsorge merely discloses a portable device with camera and telephone features in a single body. Accordingly, Applicant respectfully submits that the obviousness-type double patenting rejection is improper and requests the withdrawal of the rejection.

CLAIM REJECTIONS

The Examiner rejected claims 10-16, under 35 U.S.C. §103(a), as allegedly being unpatentable over Okuyama (U.S. Patent No. 5,689,736) in view of Ohnsorge (U.S. Patent No. 5,485,504); and rejected claims 17-18, under 35 U.S.C. §103(a), as allegedly being unpatentable over Okuyama, in view of Ohnsorge, and further in view of Nakao (U.S. Patent No. 5,161,025).

As indicated above, independent claim 1 positively recites, *inter alia*, the feature of: portable telephone comprises a telephone unit and *a unit separate from said telephone unit, said separate unit being connected to said telephone unit via a connector and having said two-dimensional display element and said magnifying optical system disposed therein.*

With this said, Applicant respectfully submits that the Okuyama and Ohnsorge citations relied upon by the Examiner do little in the way rendering Applicant's claims 10-18 obvious. The Examiner acknowledges on page 5 of the Office Action, that Okuyama fails to disclose a portable telephone. Okuyama, merely discloses an image observation system for the finder of a video camera, and fails to teach or suggest any specific structure (for example, units being separate from one another) with respect to the elements of the optical system. Moreover, as mentioned above, Ohnsorge merely discloses a portable device with camera and telephone features in a *single* body. Hence, Applicant submits that there no recitation or suggestion in Okuyama or Ohnsorge, whatsoever, of a portable telephone comprising a telephone unit and *a unit separate from said telephone unit, said separate unit being connected to said telephone unit via a connector and having said two-dimensional display element and said magnifying optical system disposed therein*, as required by Applicant's independent claim 10.

Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one in ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d (BNA) 1596, 1598-99 (Fed. Cir. 1988)

Applicant submits the Examiner has failed to set forth a legally proper teaching, suggestion, or motivation to modify Okuyama to include teachings of Ohnsorge. For example, with regard to claim 10, the Examiner acknowledges that Okuyama does not disclose the claimed portable telephone. The Examiner relies on Ohnsorge, however, for this feature, alleging that: (Office Action, page 5-6)

It would have been obvious to one of ordinary skill in the art to construct a portable telephone in view of teachings of the Okuyama and Ohnsorge to arrive at the Applicant's claimed invention so as to provide users maximum independence and freedom of movement like mobile telephones in addition to video capabilities as taught by Ohnsorge

Applicant disagrees. A simple statement that a modification or combination would have been obvious to one of ordinary skill in the art is not sufficient to provide a motivation for the proposed combination, absent a teaching within the references themselves, or in the knowledge generally available to one or ordinary skill in the art, suggesting the *desirability* of

combining the references. In fact, Ohnsorge itself fails to disclose the features of claim 10 of the claimed invention, as Ohnsorge merely discloses a portable device with camera and telephone features in a *single* body, rather than, a portable telephone comprising a telephone unit and *a unit separate from said telephone unit, said separate unit being connected to said telephone unit via a connector and having said two-dimensional display element and said magnifying optical system disposed therein*. Accordingly, Applicant submits that the rejection is improper and respectfully requests the withdrawal of the prior art rejection of claim 10.

Furthermore, the remaining reference, Nakao, is incapable of curing the deficiencies of Okuyama and Ohnsorge identified above. Thus, for at least these reasons, Applicant submits that none of the asserted references, whether taken alone or in reasonable combination, teach or suggest the claimed combination of elements recited by amended claim 10. As such, claim 10 is clearly patentable. And, because claims 11-18 depend from claim 10, either directly or indirectly, claims 11-18 are patentable at least by virtue of dependency as well as for their additional recitations. Accordingly, the immediate withdrawal of the prior art rejections of claims 10-18 is respectfully requested.

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CONCLUSION

All matters having been addressed and in view of the foregoing, Applicant respectfully requests the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicant's Counsel remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the Undersigned at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number **03-3975**.

The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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